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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY L. HUCKINS

Appeal 2008-2376
Application 09/652,168
Technology Center 2100

Decided:¹ April 27, 2009

Before JOHN C. MARTIN, LEE E. BARRETT, and JOSEPH L. DIXON,
Administrative Patent Judges.

MARTIN, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from (Continued on next page.)

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 45-55, which are all of the pending claims.

We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part and enter a new ground of rejection.

A. Appellant's invention

Appellant's invention relates generally to providing messages to clients in multicast networks. Specification 1:2-3.

Figure 1 is reproduced below.

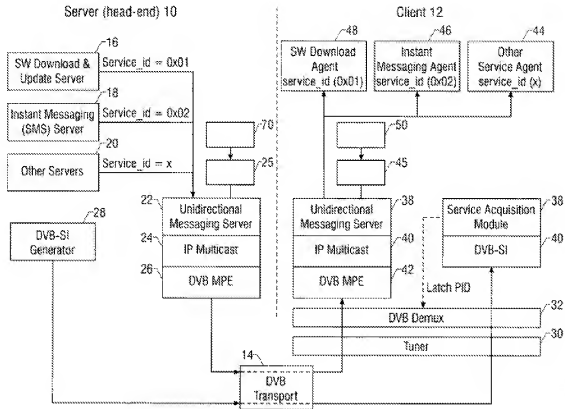


FIG. 1

Figure 1 is a schematic depiction of one embodiment of Appellant's invention. *Id.* at 2:7-8.

Client 12 may include one or more addressable agents 44, 46 and 48 that may be independently addressed by remote units such as the server 10. *Id.* at 3:16-18. Moreover, by providing addressable agents 44, 46 and 48 within a given client 12, messages that are specialized or which need specialized handling may be addressed to particular agents resident on the client 12 for appropriate handling. *Id.* at 3:18-22.

In one embodiment of the present invention, messages from the instant messaging server 18 in server 10 may include a service identifier that causes those messages to be forwarded to an instant messaging agent 46 in the client 12. *Id.* at 6:10-13. Similarly, the software download and update server 16 in server 10 may include a service identifier that causes its message to be received by software download agent 48 in client 12. *Id.* at 6:6-10.

B. The claims

The independent claims are claims 45 and 51, of which claim 45 reads:

45. A method comprising:
assigning a different address to each of at least two
agents on a client system of a multicast system; and
determining whether a message sent to a plurality of
client systems of the multicast system and received by said
client system is addressed to one of said at least two agents.

C. The references and rejection

The Examiner relies on the following references:

Kauffman et al. (Kauffman)	US 5,260,778	Nov. 9, 1993
Fletcher et al. (Fletcher)	US 6,009,274	Dec. 28, 1999
Hofmann et al. (Hofmann)	US 6,236,983 B1	May 22, 2001

Claims 45 and 51 stand rejected under 35 U.S.C. § 102(e) for anticipation by Hofmann. Answer 3.

Claims 46-49 stand rejected under § 103(a) for obviousness over Hofmann in view of Fletcher. *Id.* at 4.

Claims 50 and 52-55 stand rejected under § 103(a) for obviousness over Hofmann in view of Kauffman. *Id.* at 6.

Appellant separately argues the merits of many of the claims.

THE ISSUES

The issues raised by Appellant's arguments (discussed *infra*) regarding claim 45 are whether Appellant has shown² that the Examiner erred in finding that:

- (1) Hofmann's unique agent identifiers are agent addresses;
- (2) Hofmann's client system is part of a multicast system; and
- (3) Hofmann's client system receives messages addressed to agents.

² Appellant has the burden to show reversible error by the Examiner in maintaining the rejection. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

THE HOFMANN REFERENCE

Hofmann discloses a system for passively and actively collecting information about a device, such as a computing device and/or the user of the device. Hofmann, col. 1, ll. 56-59. The system uses one or more discovery agents to collect information about a device or its user and one or more discovery rules to determine what, if any, action is to be taken based on the collected data. *Id.*, col. 1, ll. 59-67.

Figure 1 is reproduced below.

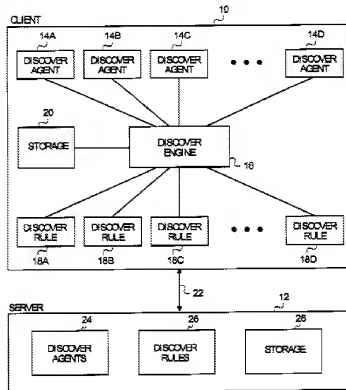


FIG. 1

Figure 1 illustrates an embodiment of a client and a server capable of implementing Hofmann's invention. *Id.*, col. 2, ll. 24-26.

Client 10 includes multiple discovery agents 14a, 14b, 14c, and 14d, discovery rules 18a, 18b, 18c, and 18d, and a discovery engine 16. *Id.*, col. 3, ll. 62-66; col. 4, ll. 18-19.

Figure 1 shows that server 12 includes discovery agents 24, discover rules 26, and storage 28. Hofmann explains that:

[a]lthough server 12 contains discovery agents 24 and discovery rules 26, the server does not necessarily activate the discovery agents or execute the discovery rules. Instead, the server stores various discovery agents 24 and discovery rules 26 for transmission to one or more clients, which are then activated or executed by the discovery engine contained in the client.

Id., col. 5, ll. 13-19.

Figure 2 is reproduced below.

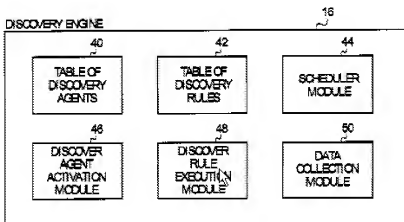


FIG. 2

Figure 2 illustrates an embodiment of a discovery engine 16 that receives data collected by one or more discovery agents and applies the collected data to one or more discovery rules. *Id.*, col. 5, ll. 49-51.

Discovery engine 16 includes a table of discovery agents 40, which contains information about the various discovery agents contained in the client. *Id.* col. 5, ll. 52-54. Table 40 includes, for example, the name (or other unique identifier) of the discovery agent, the type of data collected by the discovery agent when the agent is activated, and the typical time interval between activations of the discovery agent. *Id.*, col. 5, ll. 54-58. Module 46 is able to determine whether or not a particular discovery agent should be activated when an activation signal is received from scheduler module 44 or another event. *Id.*, col. 6, ll. 23-26.

Discovery engine 16 also includes a table of discovery rules 42, which contains the name (or other unique identifier) of each discovery rule contained in the client and information regarding the data required to execute each discovery rule. *Id.*, col. 5, ll. 61-65.

Discovery engine 16 also includes a scheduler module 44. *Id.*, col. 6, l. 3. Particular discovery agents may require activation and periodic time intervals (e.g., activated once every two seconds or once every minute). *Id.*, col. 6, ll. 4-6. When a particular discovery agent is scheduled to be activated, scheduler module 44 causes a discovery agent activation module 46 to perform the steps necessary to activate the discovery agent. *Id.*, col. 6, ll. 12-15.

Additionally, discovery agent activation module 46 may receive requests to activate a particular discovery agent from an external source (such as an activity or an event) other than the expiration of a time interval.

Id., col. 6, ll. 15-19. These external activities or events may be received from another device coupled to a common network. *Id.*, col. 6, ll. 19-20.

Hofmann also describes using a server to update discovery agents and rules in the clients. *Id.*, col. 3, ll. 35-47; col. 9, ll. 40-49. The discovery agents and discovery rules may be updated periodically by one or more servers or other software distribution mechanisms. *Id.*, col. 9, ll. 40-42. This updating allows the discovery agents and the discovery rules to be updated independently of one another. *Id.*, col. 9, ll. 42-44. The discovery agents are not associated with a particular discovery rule, and the updating of an agent does not directly affect the content of any of the discovery rules. *Id.*, col. 9, ll. 45-47. Similarly, the updating of one or more discovery rules does not directly affect the content of any of the discovery agents. *Id.*, col. 9, ll. 48-49.

THE § 102(e) REJECTION OF CLAIM 45

A. *Whether Hofmann's unique agent identifiers are agent addresses*

Regarding the first step of claim 45 ("assigning a different address to each of at least two agents on a client system of a multicast system"), the Examiner reads the two recited agents on Hofmann's discovery agents and reads the recited addresses on the unique identifiers for those agents. Final Action 4, para. 10. Appellant argues that "[t]his unique associated identifier is nowhere disclosed in Hofmann to be an address" (Br. 12), to which the Examiner responded by finding that "address" is defined in *Merriam-*

Webster's Collegiate Dictionary as "to identify (as a peripheral or memory location) by an address or a name for information transfer."³ Answer 7-8. Appellant has not asserted, let alone demonstrated, that the Examiner's interpretation of "address" is unduly broad. Appellant therefore has not shown that the Examiner erred in reading the claimed agent addresses on Hofmann's agent identifiers.

We note that the first step of claim 45 does not indicate whether the agents are addressed by means located within "said client system" or by means (e.g., a server) located outside "said client system."

B. Whether Hofmann's client system is part of a multicast system

Regarding the requirement of the first and second steps of claim 45 that the client system be part of a "multicast system," the Examiner, after finding that "multicasting" is defined in *Merriam-Webster's Collegiate Dictionary* as "the process of sending a message simultaneously to more than one destination on a network" (Answer 8), further found that:

Hofmann discloses multiple clients may be coupled to server through a network [col 5, lines 5-11 and lines 26-30], and the server stores various discovery agents and discovery rules for transmission to one or more clients, which are then activated or executed by the discovery engines contained in the client [i.e.

³ The record before us does not contain a copy of the dictionary page containing this or the other definition (*infra*) relied on by the Examiner. However, Appellant does dispute the accuracy or relevance of those definitions.

transmission to more than one destination or client or multicasting] [col 5, lines 16-19]. Therefore, the prior art clearly teaches [a] “multicasting system”

Id. at 12. Although Hofmann discloses using the server to transmit discovery agents 24 and discovery rules 26 to one or more clients (Hofmann, col. 5, ll. 16-18), we agree with Appellant that Hofmann does not describe the server as sending discovery agents and discovery rules for transmission *simultaneously* to plural clients, as required by the Examiner’s definition of multicasting. Reply Br. 1-2. Nor is such simultaneous transmission inherent in Hofmann’s disclosure.

Consequently, Appellant has shown that the Examiner erred in finding that Hofmann’s client system is part of a multicast system.

C. Whether Hofmann’s client system receives messages addressed to agents

Regarding the requirement of the second step of claim 45 for “determining whether a message . . . received by said client system is addressed to one of said at least two agents,” the Examiner found that:

Hofmann discloses the server transmits various discovery agents and discovery rules to one or more client[s] Furthermore, Hofmann discloses the discovery engine of the client is responsible for determining what data is required by a particular discovery rule and activating the appropriate discovery agents to collect the required data [i.e. determining whether a message sent to multiple client systems of a multicast system and received by the client system is addressed to an agent of the system] [col 3, lines 17-20; col 6, lines 23-26; and col 8, lines 11-14].

Answer 9. Appellant argues that:

regardless of whether the discovery agent [*sic*, engine] “is responsible for determining what data is required by a particular discovery rule and activating the appropriate discovery agents,” this does not mean that the *server* addresses specific agents. For example, messages could be addressed to the client and then the client itself forwards the messages to any agents that are to receive them.

Reply Br. 2 (emphasis added). Whether or not this argument is responsive to the Examiner’s above-quoted reasoning, it is unconvincing because it fails to address Hofmann’s above-noted disclosure that a discovery agent can be updated periodically by one or more servers or other software distribution mechanisms (*id.*, col. 9, ll. 40-47), which would seem to require that the server specifically address the discovery agent that is to be updated. The argument also fails to address Hofmann’s above-noted disclosure that the discovery agent activation module 46 can receive requests to activate a particular discovery agent from an external source (such as an activity or an event) (*id.*, col. 6, ll. 15-19), which we understand to mean a source external to the client.

For the foregoing reasons, Appellant has not shown that the Examiner erred in finding that Hofmann’s client system receives messages addressed to agents.

D. Conclusion regarding § 102(e) rejection of claim 45

Because Appellant has shown that the Examiner erred in finding that Hofmann's client is part of a multicast system, we are reversing the rejection of claim 45 for anticipation by Hofmann.

THE § 102(e) REJECTION OF CLAIM 51

Claim 51 reads as follows:

51. A system comprising:

a processor-based device including a first addressable agent and a second addressable agent, the processor-based device comprising a client system of a multicast network; and

a storage coupled to said processor-based device storing instructions that enable the processor-based device to assign a different address to the first and second addressable agents and determine whether a message sent to a plurality of client systems of the multicast network and received by said client system is addressed to one of the first and second addressable agents.

For the reasons given above in the discussion of claim 45, we agree with Appellant that the Examiner erred in finding that Hofmann's client 10 is a "client system of a multicast network" and are accordingly reversing the rejection of claim 51.

THE § 103(a) REJECTION OF CLAIMS 46-49

Claims 46-49 stand rejected over Hofmann in view of Fletcher.

Although we are reversing the § 102(e) rejection of claim 45 for anticipation by Hofmann, it does not necessarily follow that the claims that depend on claim 45 would have been unobvious over Hofmann considered

in view of Fletcher, as suggested by Appellant's argument that "[t]he rejection is improper, at least for the same reasons as claim 45 . . . , from which claim 46 depends." Br. 14.

Claim 46 reads as follows:

46. The method of claim 45 including receiving at least two different types of messages at said client system including a software update message and a short message service message.

Fletcher's invention relates to automatically updating and distributing executable files and components via a network in a distributed fashion. Fletcher, col. 1, ll. 13-15. Fletcher employs two types of primary components: (1) ASU (automatic software updating⁴) agents that reside in the ESs (End Systems⁵), such as personal computers⁶; and (2) an ASU server that advertises available versions of software components to all agents within its domain and updates those agents in response to agent requests for the newer versions of software components. *Id.*, col. 7, ll. 1-7.

According to an embodiment of the invention, the ASU agents, which are software or software plus hardware components, are placed within each (or a subset) of the ESs, such as 50a-c, 51a-c, and 52a-g (Fig. 1). *Id.*, col. 5, ll. 7-11. The agent executable code is launched each time an ES is started or rebooted. *Id.*, col. 7, ll. 10-11.

⁴ Fletcher, col. 5, l. 7.

⁵ Fletcher, col. 1, ll. 52-53.

⁶ Fletcher, col. 1, ll. 54-56.

The ASU server “uses multicast requests, or advertisements, to identify the latest version levels for one or more components that are currently available.” *Id.*, col. 10, ll. 19-21. The ASU server sends out a multicast advertisement to all agents in its domain every polling interval, for example. *Id.*, col. 10, ll. 33-35.

In one embodiment, ASU agents receive the broadcast information and compare the latest version information with the version levels of the components that they are currently running. *Id.*, col. 10, ll. 53-56. If there is any discrepancy, ASU agents with down-version components (components that are indicated outdated) respond by requesting updated versions. *Id.*, col. 10, ll. 56-58.

Update components are transferred from the ASU server to an agent in a “safe” communication session governed by a “reliable” ASU protocol. *Id.*, col. 8, ll. 34-36. Individual sessions are set up between each agent and the ASU server after the ASU server has decided to send update files. *Id.*, col. 8, ll. 36-38. The ASU server can update a single agent by establishing a single communication session with that agent, resulting in agents being updated in an agent-by-agent manner. *Id.*, col. 8, ll. 38-41. Or the ASU server can establish multiple, concurrent communication sessions with multiple agents and update components simultaneously in a file-by-file manner, for example. *Id.*, col. 8, ll. 41-44. In one embodiment, “keep alive” messages, or packets, flow between agent and ASU server on a periodic basis whether the connection is doing anything or not. *Id.*, col. 8, ll. 50-54.

Although the Examiner initially (Final Action 5) read the recited “short message service message” on Fletcher’s “keep alive” messages, the Examiner subsequently (Answer 11, para. A) read that limitation instead on Fletcher’s disclosure that “[w]hen a system software component of the end-system is updated by the ASU agent, a message is displayed to the user to this effect. This message is customizable on a per component basis by the administrator from the ASU Mgr.” Fletcher, col. 13, ll. 36-39.

Appellant argues that Fletcher fails to disclose a “short message service message,” which Appellant contends (Br. 15) is a “message service offered by the GSM digital or cellular telephone system,” citing a definition of “short message service” from FOLDDOC, the *Free On-Line Dictionary of Computers*, <http://foldoc.org/foldoc>[illegible]. Evid. App., Br. 23. This argument is unpersuasive because the claim term “short message service” is not so defined in Appellant’s Specification and thus must be given its broadest reasonable interpretation consistent with Appellant’s disclosure. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). Appellant therefore has not shown that the Examiner erred in reading the term “short message service message” on Fletcher’s message indicating a completed update operation.

Appellant’s above-noted argument that “[t]he rejection is improper, at least for the same reasons as claim 45 . . . , from which claim 46 depends” (Br. 14) is unconvincing because Appellant has not explained why the “multicast system” limitation of claim 45 that we found is not disclosed in Hofmann would not have been suggested by the combination of Hoffman

and Fletcher. As explained below, we understand the rejection of claim 46 to be based in part on Fletcher's disclosure of "us[ing] multicast requests, or advertisements, to identify the latest version levels for one or more components that are currently available." Fletcher, col. 10, ll. 19-21.

Appellant further argues (Br. 14) that the Examiner has failed to establish any motivation for combining the teachings of Hofmann and Fletcher in a way that satisfies claim 46. The Examiner initially explained that "[i]t would have been obvious to a person skill in the art at the time the invention was made to combine the teaching[s] of Hofmann and Fletcher because Fletcher's teaching of different types of messages would allow to [*sic*] identify messages and to provide multiple services in a distributed environment." Final Action 5. Appellant responded by arguing that:

[n]owhere does this contended reasoning anywhere provide a motivation for the claimed subject matter, namely the assigning of different addresses to different agents in a single client system of a multicast system, and determining whether a message sent to multiple client systems and received by the client system is addressed to one of the agents.

Br. 14. The Examiner responded to this argument by pointing out that although Hofmann discloses that updating of discovery agents and discovery rules can be accomplished by downloading agents or rules from a server (Hofmann, col. 3, ll. 34-47), Hofmann does not specifically disclose a software update message and a short message service message, and then explaining:

Fletcher discloses an automatic software updating (ASU) server for sending out a multicast advertisement or announced the

available of software component to all agents in its domain [i.e. a software update message] [col 7, lines 1-7; and col 10, lines 33-51] and when a system software component of the end-system is updated by the ASU agent, a message is displayed to the user to this effect, the message is customizable on a per component basis by the administrator from the ASU manager [i.e. a short message service message] [col 13, lines 36- 39], wherein it would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hofmann and Fletcher because Fletcher's teaching of server sending out a multicast advertisement to all agents would provide an automatically updating and distributing executable files and components via a network in a distributed fashion [col 1, lines 12-16].

Answer 11-12, para. B (bracketed text in original). We understand the Examiner's position to be that it would have been obvious to use Fletcher's updating techniques, including the *multicasting* of software version advertisements, the downloading of software updates, and the issuance of messages indicating completion of software updates, to perform updates on Hofmann's discovery agents and discovery rules. The Reply Brief does not point out any error in the foregoing rationale, instead being limited to a discussion of the § 102(e) rejection of claim 45 and 51.

Because Appellant has not shown that the Examiner erred in rejecting claim 46 for obviousness over Hofmann in view of Fletcher, we are affirming the rejection of that claim and also the rejection of claim 47, which depends on claim 46 and is not separately argued.

Claims 48 and 49, which are separately argued, and unargued claim 47, on which claims 48 and 49 directly and indirectly depend, read as follows:

47. The method of claim 46 including receiving messages including software and messages not including software.

48. The method of claim 47 including receiving different addresses with messages that include software and messages that do not include software.

49. The method of claim 48 further comprising determining if the messages including software are directed to an agent on the client system to handle the downloading of software based upon a service identifier associated with the agent.

Regarding claim 48, the Examiner initially merely cited Fletcher's column 1, line 66 to column 2, line 35. Final Action 5, para. 16. Appellant responded by arguing that:

all that the cited portions of Fletcher teach is that end systems transmit packets having destination and source addresses. Nowhere however does Fletcher teach or suggest that such source and destination addresses change based on a type of message. Instead it appears the opposite is true: source and destination addresses remain the same regardless of message type.

Br. 15. The Examiner responded by relying on different passages in Fletcher:

Fletcher discloses a method steps [*sic*] for the server sends out a multicast advertisement to all agents in its domain [i.e. messages that do not include software], once all responses have been received from the agents, the server sends out files in a

point-to-point manner to each agent requesting that file [i.e. messages that includes software] [col 10, lines 33-51; and col 11, lines 67-col 12, lines 18].

Answer 12 (bracketed text in original). Because Appellant has not addressed the Examiner's above reasoning, we are affirming the rejection of claim 48.

For the same reason, we are also affirming the rejection of claim 49. Although the Examiner initially cited only the Abstract and column 3, lines 40-44 (Final Action 5), the Examiner in the Answer (at 13, para. D) relied instead on element 306 in Figure 5, column 5, lines 26-44, and column 12, lines 40-45, which reliance is not addressed in the Reply Brief.

In summary, we are affirming the rejection of claims 46-49 for obviousness over Hofmann in view of Fletcher.

THE § 103(a) REJECTION OF CLAIMS 50 AND 52-55

Claims 50 and 52-55 stand rejected under § 103(a) for obviousness over Hofmann in view of Kauffman.

Claim 50 reads:

50. The method of claim 45 further comprising determining whether a message is sent to a first client system of the multicast system or a subset of the plurality of client systems based upon an individual identifier of the first client system and a group identifier of the subset of the plurality of client systems.

Kauffman's invention relates generally to communications networks, and more particularly to the selective distribution of messages to subscribers on a cable television network or the like. Kauffman, col. 1, ll. 7-10.

Kauffman explains that it would be advantageous to provide for the distribution of specific messages to individual subscribers or special groups of subscribers via a CATV communications network or the like. *Id.*, col. 1, ll. 41-44.

At the cable system headend, an addressable controller 24 (Fig. 1) enables the system operator to communicate with individual subscriber converters. *Id.*, col. 3, ll. 49-51. Addressable controller 24 additionally contains grouping information relating subscribers to specific messaging groups. *Id.*, col. 3, ll. 59-62. Each subscriber terminal in the system is assigned to a primary message group and may be additionally assigned to one or more message subgroups. *Id.*, col. 3, ll. 62-64. The terminal is also identified by a unique address. *Id.*, col. 3, ll. 64-65. In this manner, addressable controller 24 allows messages to be selectively disseminated to individual subscribers, to specific groups of subscribers, or to all subscribers. *Id.*, col. 3, ll. 65-68. As an example, a particular system may assign primary group identifiers to each different geographic hub in the system, and a subgroup identifier may define civil defense workers. *Id.*, col. 4, ll. 59-62.

The user's terminal (i.e., converter) includes an RF converter 42 (Fig. 2) for tuning to the desired cable channel (Kauffman, col. 5, l. 3) and an addressable data receiver 54 for receiving the messages (*id.*, col. 5, ll. 28-33. Microprocessor 56 determines which messages are intended for that terminal. *Id.*, col. 5, ll. 33-38. "All messages that are directed to the converter either specifically (e.g., via the converter's unique address), by

group, or globally are stored in RAM 60 for subsequent retrieval and display.” *Id.*, col. 5, ll. 39-42 (bolding omitted). Thus, messages intended for a group appear to be sent simultaneously to all group members, i.e., multicast.

A message indicia light 19 is provided on the user’s converter to advise a subscriber that a message has been stored in the converter for retrieval. *Id.*, col. 3, ll. 42-45.

In the Final Action, the Examiner reasoned:

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hofmann and Kauffman because Kauffman's teaching of group and subset of client and identifiers would allow to provide for the distribution of specific messages to individual subscribers or special groups of subscribers via a CATV communication network, such messages include the service of emergency alert information, reminder message, paging message, etc...
[Kauffman, col 1, lines 41-51].

Final Action 6 (bracketed text in original).

Appellant responded with several arguments, the first being that “[t]he rejection of claim 50 is improper, at least for the same reasons discussed above regarding claim 45 from which claim 50 depends”

Br. 16. This argument is unconvincing because Appellant has not explained why the “multicast system” limitation of claim 45 that we found is not disclosed in Hofmann would not have been suggested by the combination of Hoffman and Kauffman. As noted above, the rejection of claim 50 is based in part on Kauffman’s disclosure of distributing of specific messages to individual subscribers or special groups of subscribers. Final Action 6

(citing Kauffman, col. 1, ll. 41-44). As explained above, messages intended for a group appear to be sent simultaneously to all group members, i.e., multicast. *See* Kauffman, col. 5, ll. 39-42 (“All messages that are directed to the converter either specifically (e.g., via the converter’s unique address), by group, or globally are stored in RAM 60 for subsequent retrieval and display.”) (bolding omitted).

Appellant also argues that Kaufman is from a non-analogous art (Br. 16). “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). Specifically, Appellant argued that:

the primary reference, Hofmann is directed to a computer system and more particularly to a client/server architecture, in which information regarding the client system can be *retrieved from* the client system. Hofmann, cols. 1-2. In contrast, Kauffman is directed to a cable television system in which text/graphics messages are *transmitted to* subscribers or groups of subscribers. Kauffman, Abstract. As such, clearly Kauffman is from a non-analogous art. MPEP §2141.01(a).

Br. 16 (emphasis added). The Examiner responded to this argument by finding that Kauffman is relevant to Hofmann’s function of sending discovery agents and discovery rules *from* the server *to* one or more clients. *See* Answer 15 (“Hofmann discloses the server stored various discovery agents and discovery rules for transmission to one or more clients [col 5, lines 16-19].”) (bracketed text in original). The text cited in that statement

explains that “the server stores various discovery agents 24 and discovery rules 26 for transmission to one or more clients, which are then activated or executed by the discovery engine contained in the client.” The Reply Brief has not addressed, let alone shown any error in, the Examiner’s explanation of why Kauffman would have been considered relevant to Hofmann.

Finally, Appellant questions the Examiner’s above-quoted rationale for combining the reference teachings, arguing:

[T]he Examiner contends that it would have been obvious to combine these references “to provide for the distribution of specific messages to individual subscribers or special groups of subscribers via a CATV communication network” Final Office Action, p. 6. However, this is not what is claimed in claim 50 or any other rejected claim. The references must provide “the desirability of making the specific combination that was made by the applicant.” *In re Kotzab*, [217 F.3d 1365, 1369,] 55 USPQ2d [1313,] 1316-17 [(Fed. Cir. 2000)]. Because no such showing is present here, the rejection should be reversed.

Br. 17. This argument is unconvincing because Appellant has not explained why it would have been unobvious to combine the reference teachings for the reasons proposed by the Examiner or why the claim language does not read on the resulting combination of teachings. The motivation for combining the reference teachings need not be directed to the problem addressed by Appellant: “[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *In re ICON*

Health and Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007) (quoting *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007)).

The rejection of claim 50 is therefore affirmed.

Claims 52-55 depend either directly or indirectly on independent claim 51, the § 102(e) rejection of which has been reversed because Hofmann fails to satisfy the “multicast” limitation.

Claim 52 reads:

52. The system of claim 51 wherein the system further comprises a service acquisition module to receive a broadcast data stream and provide a program identifier to a tuner of the processor-based device, and to extract the message and to provide the message to a unidirectional messaging module of the processor-based device.

For this feature, the Examiner initially relied on Kauffman’s column 4, line 66 to column 5, line 47. Final Action 6. These lines describe using RF converter 42 (Fig. 2) to tune to the desired cable channel (Kauffman, col. 5, l. 3) and also describe using addressable data receiver 54 to receive message signals (*id.*, col. 5, ll. 28-33). In the Answer, the Examiner more specifically relies on Kauffman’s discussion of using RF converter 42 “to tune to a particular channel to receive a desired service for display on television set 20” (*id.*, col. 3, ll. 34-42) and also on Kauffman’s column 5, lines 21-12, which describe using the RF converter to tune to a desired cable channel (col. 5, ll. 2-12). Answer 16, para. B.

Appellant’s argument that claim 52 is patentable at least for the same reasons as independent claim 51 (Br. 17) is unpersuasive for the reasons given above in the discussion of the same argument as applied to claim 50.

Appellant also questions the Examiner's finding that Kauffman discloses "provid[ing] a program identifier to a tuner," arguing that "Kauffman only teaches that a cable channel is delivered to a tuner, not a program identifier." Br. 17. We do not agree. Appellant has not explained why the claim term "program identifier" cannot be read on the information that is used to control the RF modulator in order to tune it to the desired channel. Consequently, we are affirming the rejection of claim 52.

Claim 53 read as follows:

53. The system of claim 52 wherein the unidirectional messaging module is to determine if the message is addressed to the first addressable agent or the second addressable agent.

The Examiner stated that claim 53 is unpatentable for the reasons given in the discussion of the rejection of claims 45 and 49. Answer 16, para. C.

Appellant's argument that the rejection of this claim is improper at least for the same reasons as the rejection of claim 52 (Br. 17) is unconvincing because those reasons are unpersuasive as applied to claim 52. Appellant also argues that claim 53 is patentable "as Hofmann nowhere teaches or suggests multiple addressable agents of a single system, as discussed above regarding claim 45." *Id.* This argument is unconvincing because we found that Hofmann does teach multiple addressable agents. Also, Appellant has not demonstrated that the above-identified claim 45 limitation is not disclosed or suggested by the combination of Hoffman and Kauffman. The rejection of claim 53 is therefore affirmed.

Claim 54 reads:

54. The system of claim 52 wherein the unidirectional messaging module to determine if the message is addressed to the first addressable agent or the second addressable agent based upon a service identifier within the message.

The Examiner concluded that claim 54 is unpatentable for the reasons given in the discussion of the rejection of claims 45 and 49. Answer 16, para. D. Appellant argues that “neither reference [Hofmann nor Kauffman] anywhere teaches or suggest a service identifier.” Br. 18. As noted by Appellant, the Examiner’s reliance on claim 49 is misplaced because that claim was rejected for obviousness over Hoffman in view of Fletcher, not over Hoffman in view of Kauffman. *Id.* Because the Examiner has not explained how the term “service identifier” is being read on the combined teachings of Hofmann and Kauffman, we are reversing the rejection of claim 54.

Claim 55 reads:

55. The system of claim 51 wherein the storage is to further store instructions that enable the processor-based device to determine whether a message is directed to a first client system of the multicast network or a subset of the plurality of client systems of the multicast network based upon an individual identifier of the first client system and a group identifier of the subset of the plurality of client systems.

The Examiner concluded that claim 55 is unpatentable for the reasons given in the discussion of the rejection of claims 50 and 51. Answer 16, para. E. Appellant’s argument (Br. 18) that claim 55 is patentable for at least the same reasons as independent claim 51 is unpersuasive for the

reasons given above in the discussion the same argument as applied to claim 50.

The rejection of claim 55 is therefore affirmed.

DECISION ON THE EXAMINER'S REJECTIONS

The rejection of claims 45 and 51 under 35 U.S.C. § 102(e) for anticipation by Hofmann is reversed.

The rejection of claims 46-49 under § 103(a) for obviousness over Hofmann in view of Fletcher is affirmed.

The rejection of claims 50 and 52-55 under § 103(a) for obviousness over Hofmann in view of Kauffman is affirmed with respect to claims 50, 52, 53 and 55 and reversed with respect to claim 54.

The Examiner's decision that claims 45-55 are unpatentable over the prior art is therefore affirmed-in-part.

NEW GROUNDS OF REJECTION

The affirmance of a § 103(a) rejection of a dependent claim for obviousness over prior art implies the obviousness of the subject matter recited in the parent claim over the same prior art. *Aventis Pharma Deutschland GmbH v. Lupin, Ltd.*, 499 F.3d 1293, 1300 (Fed. Cir. 2007); *Ormco Corp. v. Align Tech., Inc.*, 498 F.3d 1307, 1319-20 (Fed. Cir. 2007); *In re Muchmore*, 433 F.2d 824, 824-25 (CCPA 1970). For that reason, pursuant to our authority under 37 C.F.R. § 41.50(b), we hereby enter the following new grounds of rejection of independent claims 45 and 51:

A. Claim 45 is rejected under § 103(a) over Hofmann in view of Fletcher for the reasons given above in the affirmance of the rejection of dependent claims 46-49.

B. Claim 45 is further rejected under § 103(a) over Hofmann in view of Kauffman for the reasons given above in the affirmance of the rejection of dependent claim 50.

C. Claim 51 is rejected under § 103(a) over Hofmann in view of Kauffman for the reasons given above in the affirmance of the rejection of dependent claims 52, 53, and 55.

APPELLANT'S OPTIONS FOR RESPONDING TO THE DECISION AND NEW GROUNDS OF REJECTION

Regarding the affirmed rejections, 37 C.F.R. § 41.52(a)(1) (2008) provides that “Appellant may file a single request for rehearing within two months from the date of the original decision of the Board” (emphasis added).

Regarding the new ground of rejection pursuant to 37 C.F.R. § 41.50(b), that paragraph explains that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Appellant, within two months from the date of this decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

Appeal 2008-2376
Application 09/652,168

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .
37 C.F.R. § 41.50(b)(2008).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv)(2008).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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